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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,942	11/06/2001	Hartmus Ahrens	ACR2691PIUS	6527

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EXAMINER

HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/10/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/914,942
Filing Date: November 06, 2001
Appellant(s): AHRENS ET AL.

Ralph J. Mancini
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 8, 2004 appealing from the Office action mailed April 26, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is incorrect. No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because appellants have not made reference to page and line number as in part (1). In addition, the appellants state that the disclosed compounds are halogen free. Appellants have not claimed halogen free compounds or compositions. In fact, the recited counterions may explicitly be halogens. See the first four definitions of X in claim 1.

(6) *Grounds of Rejection to be Reviewed Upon Appeal*

The appellants' statement of the grounds of rejection is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

EP 330,261	HARDY et al.	8-1989
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-6, 8 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over EP 330,261 A1. The reference discloses fabric softening compositions comprising 2-hydroxypropyl monoesters of the form shown in the figure at p. 4, line 55. R¹ is a hydrocarbyl group of 14-22 carbons; R² is a hydrocarbyl group of 13-21 carbons; and R is alkyl or hydroxyalkyl of 1-6 carbons (p. 5, top). All of the R groups may be unsaturated. Fabric softening compositions according to the invention comprise about 1-20% of this monoester and a carrier solvent (p. 3, lines 49+). These compositions may further comprise cationic and nonionic surfactants (examples, p. 6, lines 55+). These compositions do not comprise a quat exactly as portrayed in claim 1. However, it would have been obvious at the time the invention was made to incorporate such a quat, because the prior art quats are one-carbon homologs of quat II of claim 1. Accordingly, the person of ordinary skill in the surfactant art would expect the claimed quat to have the same properties as those of the prior art.

(10) Response to Argument

The crux of the issue is whether a one-carbon homolog of a known compound is obvious if preparation of that homolog requires chemistry which is different from that used to make the known compound. The examiner believes that one-carbon homologs are obvious, regardless of what is required to prepare them, and that preparation may be separately patentable, as in the present case. For the reasons stated in the brief, the appellants believe otherwise.

Appellants argue that the examiner has required a showing of unexpected results. The examiner has only stated that if appellant believes that the claimed compounds have properties other than those which the person of ordinary skill in the art would expect, a showing in support of such unexpected properties should be presented.

Appellants further argue that the claimed compounds are a more environmentally friendly class of esterquats which have no possibility of being contaminated by epichlorohydrin. This argument is not persuasive for several reasons. Appellants' arguments juxtapose the method of preparation with the characteristics of the claimed compounds. The method of preparation has been indicated allowable. The compounds themselves, being one-carbon homologs of known fabric softeners, would be expected, by the person of ordinary skill in the surfactant art, with a high degree of certainty, to successfully soften fabric. The examiner submits that "environmental friendliness" is a characteristic of the method of preparation, which is allowable over the prior art. Given the high reactivity of epichlorohydrin, the likelihood of its presence as a residual

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contaminant is nil. Furthermore, its presence in the prior art compositions is a matter of speculation, as appellants have not provided evidence of such.


Appellants argue that, were one to decide to make a compound which is a homolog of the prior art compounds, the choice of a suitable synthon would not be obvious. The examiner agrees, but again, this argument is germane to the method of synthesis, rather than to the expected properties of the target molecule.

Appellant's arguments regarding S_N2 mechanisms and availability of starting materials from Aldrich are interesting, but these arguments are relevant only to the (allowable) method claims.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

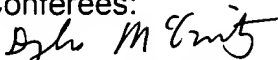


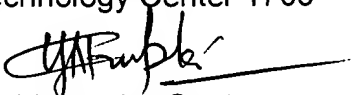
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January 4, 2005

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